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10/077,346	02/14/2002	Raymond Zappe	0144	2491

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EXAMINER

GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/077,346
Filing Date: February 14, 2002
Appellant(s): ZAPPE, RAYMOND

H. Gordon Shields
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/26/04.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 21-27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6103390	Kamiya et al.	8-2000
4,098,184	Okada et al.	7-1978
6,350,509	Sada et al.	2-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 25-26 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in a prior Office Action, mailed on 11/4/03 and is re-iterated here below:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, line 1, “relatively flexible” is recited which is vague and unclear in that the term “relatively” implies a comparison between two things and in this case the claim language does not complete the comparison but just states that the liner is “relatively flexible”. There is no reference frame from which to determine the flexibility of the liner. Specifically, it is unclear to what degree of flexibility the liner exhibits.

In claim 26, line 1, “relatively inflexible” is recited which is vague and unclear as to what feature of the invention the applicant intends to recite. Specifically, the term “relatively” implies a comparison between two objects or things and in this case the claim language does not

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complete the comparison by supporting another feature with which to compare or contrast the inflexibility of the liner. The degree of flexibility (or inflexibility) of the liner is not defined and is unclear.

(b) Claims 21-22 and 25-26 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 11/4/03.

Kamiya et al. disclose an article for a vehicle comprising in combination : a first base layer 5A; a patterned second layer 9 secured indirectly to the first base layer; and a clear third layer 10 secured to the patterned layer for permitting the patterned layer to be viewed.

The article exhibits excellent elasticity and can be flexed; therefore the article is relatively flexible. The article can be compared with other objects which are more flexible and thus in comparison be “relatively inflexible.”

With regard to the “bedliner” recitation in the preamble of the claim, this language is not believed to limit the claim. Specifically, the claim preamble has the impart that the claim as a whole suggests for it. In this case, the body of the claim makes no mention to any specific features that a bedliner would possess (such as a U-shape, a lip, or wheel well cover) and the preamble merely states the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations. Therefore, the preamble is not considered a limitation and is of no significance to claim construction. See *Kropa v. Robie*, 187 F.2d at 152, UPSQ2d at 480-81 and MPEP 2111.02.

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(c) Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiya et al. as applied to claim 21 above and further in view of Okada et al. This rejection is set forth in a prior Office Action, mailed on 11/4/03.

Kamiya et al. do not disclose the patterned layer being monochromatic or polychromatic.

Okada et al. teach a screen printing method for carrying out not only a monochromatic printing but also a polychromatic or multi-color printing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the patterned layer of Kamiya et al. to be monochromatic or polychromatic as taught by Okada et al. in order to provide a variety of designs for the article.

(d) Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiya et al. as applied to claim 21 above and further in view of Sada et al. This rejection is set forth in a prior Office Action, mailed on 11/4/03.

Kamiya et al. lack a clear fourth layer on the clear third layer.

Sada et al. teach a coating structure for vehicles with a plurality of clear coating layers, numbered 22, 22', which may be placed one upon another to obtain further improved brilliancy of the structure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied an additional clear layer as taught by Sada et al. upon the clear third layer of Kamiya et al. in order to improved the brilliancy of the article.

(11) Response to Argument

(a) With regard to the terms “relatively flexible” and “relatively inflexible” and the modification of the specification, this does not overcome the 112 second paragraph rejection.

The modification stating that the various coats may flex easily or that they may not flex sheds no light on the terms to overcome the rejection. The terms remain vague and unclear.

(b) With regard to applicant’s argument that one would not look to the Kamiya patent for a bed liner, the examiner would like to note that the “bedliner” language is not believed to limit the claim. Specifically, the claim preamble has the impart that the claim as a whole suggests for it. In this case, the body of the claim makes no mention to any specific features that a bedliner would possess (such as a U-shape, a lip, or wheel well cover) and the preamble merely states the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations. Therefore, the preamble is not considered a limitation and is of no significance to claim construction. See *Kropa v. Robie*, 187 F.2d at 152, UPSQ2d at 480-81 and MPEP 2111.02.

In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the patterned layer is “on” the base layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner believes the three layers of material are arranged in the same manner as specified in claim 21, as broadly recited and interpreted, and do indeed have the same structure.

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Specifically, a first base layer 5A is provided along with a patterned second layer 9 secured indirectly to the first base layer; and a clear third layer 10 is secured to the patterned layer for permitting the patterned layer to be viewed.

With respect to claim 22, the examiner would like to point out that the base layer 5A comprises a substrate sheet made of acrylic resin foam or polyurethane foam (Col 4, lns 12-15).

(c) In response to applicant's apparent argument that Okada et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is pertinent to the particular problem with which the applicant was concerned, namely screen printing or the application of monochromatic and polychromatic patterned layers. The Okada et al. reference teach a screen printing method for carrying out both a monochromatic as well as a polychromatic printing.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kamiya et al. disclose a patterned layer and Okada et al. teach the desirability of providing various designs using monochromatic or polychromatic printing.

Furthermore, the examiner uses the Okada et al. reference to show that screen printing is old and well known in the prior art and can be performed for both monochromatic or polychromatic printing. Since the base reference to Kamiya discloses screen printing for producing the patterned layer 9, it is apparent that the patterned layer 9 can be either monochromatic or polychromatic since the prior art shows that the screen printing process is capable of this feat.

(d) In response to applicant's apparent argument that Sada et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the field of applicant's endeavor is that of viewing a design, wording, or logo through a clear or transparent layer. Similarly, Sada et al. also relates to viewing a color base layer through one or more transparent layers.

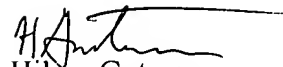
In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, Sada et al. teach the desirability or the application of additional clear layers (specifically an additional clear layer upon an underlying clear layer) in order to improved the brilliancy of the article or structure being viewed.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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March 17, 2005

Conferees

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